

recapture of broadened claim subject matter surrendered in the application for the patent upon which the present reissue is based. Claims 29-40 were rejected under 35 U.S.C. §102(b) as being anticipated by Weiss, U.S. Patent No. 4,828,186. Claims 1-28 were allowed.

35 U.S.C. §251 REJECTIONS

Claims 29-36, 39 and 40 are rejected under 35 U.S.C. §251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. Applicant respectfully disagrees as there was no subject matter surrendered to distinguish over the art of record that Applicant is now attempting to recapture.

The Examiner cites *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 U.S.P.Q.2d 1641 (Fed. Cir. 1998) for the pronouncement of the standard for determining recapture. "To determine whether an applicant surrendered particular subject matter, we look to the prosecution history arguments and changes to the claims made in an effort to **overcome a prior art rejection**. **(Emphasis added).** *Id. at 1480*. See also, *Mentor Corp. v. Coloplast, Inc.* 998 F.2d at 995-996, 27 U.S.P.Q.2d at 1524-25 (Fed. Cir. 1993); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 U.S.P.Q. 289, 294-95 (Fed. Cir. 1984).

The Examiner erroneously argues that the addition of "placed between a trim adjustment rack of a motor and the transom of the boat" in claim 1 was an equivocal surrender of all subject matter regarding a tie down bracket. Claim 18, which also includes a tie down bracket, but does not specify the placement for the bracket, was presented at the same time as the amendment to claim 1. Claim 18 is contrary to the Examiner's contention and indicates that there was no intention to unequivocally surrender all subject matter regarding a tie down bracket in a combination with other elements. To the extent that a specific location for the placement of the bracket was argued with respect to claim 1, it was not argued with respect to claim 18, therefore although there may have been surrender with respect to claim 1, there was not any surrender in regards to all claims. Claims 29, 34, 39 and 40 are directed to additional features that are disclosed and discussed in other claims and in the specification, but were not included in the previous independent claims. While some elements

are broadened, others are further clarified and narrower than previous independent claims. Therefore, this is not a matter of recapture since some of the new claims further focus previous claims.

Claims 30-33 and 35-36 were rejected under 35 U.S.C. §251 as being an improper recapture of broadened claim subject matter surrendered in the application for the patent upon which the present reissue is based. Claims 30-33 depend from claim 29 and claims 35-36 depend from claim 34. As previously set forth, claims 29 and 34 do not improperly recapture subject matter surrendered in the application for the patent upon which the present reissue is based. Claims 29 and 34, similar to claim 18, recite a tie down element but does not specify the placement of the element. Thus, claims 30-33 and 35-36 do not improperly recapture subject matter surrendered in the application for the patent.

In addition, claims 34, 39, and 40 have been amended. Claim 34 has been amended to claim a support with a cradle at the "second" end, rather than the "first" end and rotatable mount at the "first" end, rather than the "second" end. The switch of support ends was made for purposes of consistency and is supported by Figures 2, 3 and 4.

Claims 34, 39, and 40 were amended to each include "a rigid tie down member" to clarify the presence of the tie down member in the motor support device. Support for the addition is shown in Figures 2, 3 and 4. Claim 34 also includes "connectable to opposite ends of the tie down member" to further clarify the relationship between the flexible tie down member with the rigid tie down member. Support for the change is shown in Figures 2, 3 and 4. Additions of "flexible" and "connectable to the rigid tie down member" in claim 39 and "a flexible tie down element connectable to the rigid tie down member, which passes behind the motor for securing the drive shaft housing in place against the cradle when the motor is in an up position" in claim 40 were made for the same reasons as stated above for the addition of similar wording in claim 34. Support for the additions can be shown in Figures 2, 3 and 4.

Additionally, claims 29, 34, 37, 39 and 40 were amended to clarify that the support is pivotally connected at a location "above a bottom edge of the transom." Support for the changes are shown in Figures 3 and 4.

With this response, the rejection of claims 29-36, 39 and 40 have been overcome. The application is not in condition for allowance, and notice to that effect is respectfully requested.

35 U.S.C. §102(b) REJECTIONS

Claims 29-40 are rejected under U.S.C. §102(b) as being anticipated by Weiss. In order to be a §102(b) reference, the reference must teach each and every limitation of the claims. Weiss does not teach each and every limitation of the claimed invention. Weiss claims and teaches a device that is used as a boat motor support to be utilized in towing a boat on a trailer and cannot be used in water. The device is comprised of frame and motor mount brackets with adjustable telescoping arms used with cushion elements to absorb impact loads from the overhanging motor. Weiss' invention supports the boat motor with respect to the trailer. The invention of claims 29, 34, 37, 39 and 40 pivotally connects to the boat on one end at a position above the bottom edge of the transom, while the other engages and supports the motor, allowing the motor support to be used in water.

As interpreted by the Examiner, the Weiss patent includes tie down brackets 20, 24 and 28. However, elements 20 and 24 are actually the support arm which extends from the boat trailer 18 and comprises the first and second members, respectively which are telescoping in relation to the other. Further, element 28 is a pair of eyelets that are located at the end of bracket 20 and proximate to cradle 22. Claims 29, 34, 37, 39 and 40 teach a support that is connected between the boat and motor to be used when the boat is in the water. Weiss on the contrary teaches a support that is connected to a trailer and a motor to be used for transport of the motor on land. Thus, Weiss does not teach each and every limitation of the claimed invention of claims 29, 34, 37, 39 and 40. As such, claims 29, 34, 37, 39 and 40 are not anticipated by Weiss.

Claims 30-33, 35-36 and 38 were rejected under 35 U.S.C. §102(b) as being clearly anticipated by Weiss. Claims 30-33 depend from claim 29, claims 35-36 depend from claim 34, and claim 38 depend from claim 37. As previously set forth, claim 29, 34, 37, 39 and 40 are not anticipated or otherwise taught by Weiss. Weiss does not teach the use of a support connected to

First Named Inventor: Steve Poll

Application No.: 00/809,453

-13-

the boat to be utilized in water. As such, Weiss does not suggest or teach every limitation of the claimed invention. Thus, claims 30-33, 35-36 and 38 are not shown, suggested or taught by Weiss. Applicant has presented claims that are believed to be in condition for allowance and favorable action is respectfully requested.

Respectfully submitted,

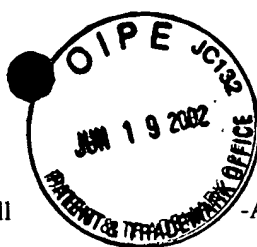
KINNEY & LANGE, P.A.

Date: 6/19/02

By 

David R. Fairbairn, Reg. No. 26,047
THE KINNEY & LANGE BUILDING
312 South Third Street
Minneapolis, MN 55415-1002
Telephone: (612) 339-1863
Fax: (612) 339-6580

DRF:HLN:imv



First Named Inventor: Steve Poll

-A1-

Application No.: 09/809,453

**APPENDIX:
MARKED UP VERSION OF SPECIFICATION AND CLAIM AMENDMENTS**

Please amend claims 29, 34, 37, 39 and 40 as follows:

29. (Amended) An outboard motor support device for securing an outboard motor to a transom of a boat, the device comprising:

- a tie down bracket;
- a support rotatably mounted with respect to the motor at a position above a bottom edge of the transom such that when the motor is in an up position the support can rotate about its mounting point to contact and support the motor and when the motor is in a down position the support is positioned between the motor and the transom; and
- a tie down element which passes behind the motor and is secured to the tie down bracket when the motor is in the up position to hold the motor in contact with the support.

34.(Amended) An outboard motor support device for securing an outboard motor to a transom of a boat, the device comprising:

- a rigid tie down member;
- a support having a cradle at a [first] second end and having a [second] first end rotatably mounted about a horizontal pivot axis which is generally parallel to the transom and located above a bottom edge of the transom such that when the motor is in an up position the support can rotate about the pivot axis to contact and support the motor in the cradle and when the motor is in a down position the support is positioned between the motor and the transom; and
- a flexible tie down element connectable to opposite ends of the tie down member which passes behind the motor to hold the motor in contact with the cradle when the motor is in its up position.

37. (Amended) An outboard motor support device for securing an outboard motor to a transom of a boat, the device comprising:

- a tie down bracket having holes at opposite ends;
- a support having a cradle at an a first end, wherein a second end of the support is mounted for pivotal movement about an axis located above a bottom edge of the transom such that when the motor is in an up position the support can rotate about its mounting point to a first position at which the cradle receives and supports the motor along a drive shaft housing of the motor and when the motor is

**APPENDIX:
MARKED UP VERSION OF SPECIFICATION AND CLAIM AMENDMENTS**

in a down position the support is in second position between the motor and the transom; and

a tie down element having a pair of hooks secured to its ends, wherein each one of the hooks is secured in one of the holes in the tie down bracket and the tie down element passes behind the drive shaft housing of the motor to hold the drive shaft housing in contact with the cradle when the motor is in the up position.

39. (Amended) An outboard motor support device for securing an outboard motor to a transom of a boat, the device comprising:

a rigid tie down member;

a support rotatably mounted at a first end and having a cradle at a second end, the support being rotatable about a pivotal axis located above a bottom edge of the transom so that when the motor is in an up position the support can rotate about its first end so that the cradle receives and supports the motor along a drive shaft housing of the motor and when the motor is in a down position the support is positioned between the motor and the transom; and

a flexible tie down element connectable to the rigid tie down member, which passes behind the motor for securing the drive shaft housing in place against the cradle when the motor is in an up position.

40. (Amended) An outboard motor support device for securing an outboard motor to a transom of a boat, the device comprising:

a rigid tie down member;

a support rotatably mounted at a first end and having a cradle at a second end, the support being rotatable about a pivotal axis located above a bottom edge of the transom so that when the motor is in an up position the support can rotate about its first end so that the cradle receives and supports the motor along a drive shaft housing of the motor and when the motor is in a down position the support is positioned between the motor and the transom;

a flexible tie down element connectable to the rigid tie down member, which passes behind the motor for securing the drive shaft housing in place against the cradle when the motor is in an up position; and means connected between the support and the motor for rotating the support upward when the motor is tilted from the down position to the up position.